Remarks

An action has been issued stating that restriction between the following groups of claims is required:

Group I: claims 1-6;

Group II- claims 7, 9 and 10 and

Group III- claim 8.

This restriction requirement is respectfully traversed.

The examiner bases this requirement on PCT Rule 13.1 (The international application shall relate to one invention only or to a group of inventions so linked as to form a single general inventive concept ("requirement of unity of invention")). However, the requirement to restrict the claims is neither necessary nor required pursuant PCT Rule 13.2. PCT Rule 13.2 sets out the test for unity of invention in cases arising under the PCT. The key test is whether there is "a technical relationship" among the subject matter of the claims involving the same special technical features, which are defined as those features which define the contribution which each of the claims makes over the prior art. For the reasons set out below, the claims meet this requirement.

Annex B of the Administrative Instructions under PCT permit:

(e) Combinations of Different Categories of Claims. The method for determining unity of invention under Rule 13.2 shall be construed as permitting, in particular, the inclusion of any one of the following combinations of claims of different categories in the same international application:

(i) in addition to an independent claim for a given product, an independent claim for a process specially adapted for the manufacture of the said product, and an independent claim for a use of the said product, or

(ii) in addition to an independent claim for a given process, an independent claim for an apparatus or means specifically designed for carrying out the said process, or

(iii) in addition to an independent claim for a given product, an independent claim for a process specially adapted for the manufacture of the said product and an independent claim for an apparatus or means specifically designed for carrying out the said process, it being understood that a process is specially adapted for the manufacture of a product if it inherently results in the product and that an apparatus or means is specifically designed for carrying out a process if the contribution over the prior art of the apparatus or means corresponds to the contribution the process makes over the prior art. Thus, a process shall be considered to be specially adapted for the manufacture of a product if the claimed process inherently results in the claimed product with the technical relationship being present between the claimed product and claimed process.

Claims 1-6 are claims drawn to a process for the preparation of metal-coated polymer nano-fibers.

Claims 7, 9 and 10 are drawn to metal-coated polymer nano-fibers obtained by the process in accordance to claim 1.

Claim 8 is drawn to a method for using metal-coated polymer nano-fibers.

This grouping is in accordance with e (i).

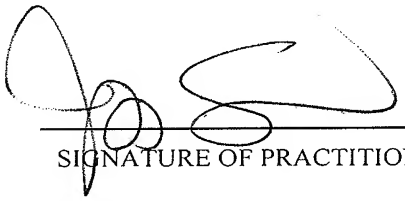
Furthermore, in accordance with the decision of Caterpillar Tractor Co. v. Commissioner of Patents and Trademarks 231 USPQ 590 (E.D. Va 1986) the U.S. P.T.O. should, when considering issues of unity in applications which are national phase entries of International applications, apply the PCT's criteria for determining unity of invention. It is often argued that in applying the holding of the Caterpillar case that the U.S.P.T.O. should give deference to the views of the International Preliminary Examination Authority on the question of unity. As held in the *Caterpillar* case, questions of unity of invention are to be regarded as matters of form and content rather than substance so that the Preliminary Examination Report is entitled to greater weight on this issue. Where the International Searching Authority has already searched all of the claims of the present application and provided an International Search Report based thereon, it is important to note MPEP §§1898.07(c):

[w]here several inventions have been searched in the parent international application, the examination of such inventions in a continuing national application may not be burdensome and the Examiner may consider all the inventions in such an application without making a restriction requirement.

Furthermore, according to the International Preliminary Examination report (copy is attached), all of the claims are novel and inventive.

Therefore, since there was no unity objection made during the international phase, the reference cited by the examiner was cited in the international search report, and the claims meet the requirements of PCT 13.2, it is respectfully requested that the requirement to restrict the claims be withdrawn.

If any fee is required, the fee may be charged Account No. 12-0425.



SIGNATURE OF PRACTITIONER

Reg. No.: 33,778

Janet I. Cord

(type or print name of practitioner)

Tel. No.: (212-708-1935)

P.O. Address

Customer No.:

00140

PATENT TRADEMARK OFFICE

c/o Ladas & Parry LLP
26 West 61st Street
New York, N.Y. 10023